The Examiner also required under 35 U.S.C. §121 election of a single disclosed species from each of the following in the event group I or II is elected:

(A) a bicyclam;
(B) an oligopeptide;
(C) a human antibody;
(D) a chimeric antibody; and
(E) a humanized antibody.

In response, applicants hereby elect with traverse the invention of group II, claims 7-12, 16 and 17, and the species of a bicyclam.

REMARKS

Applicants respectfully request that the Examiner reconsider and withdraw the restriction requirement set forth in the December 18, 2001 Office Action. Under 35 U.S.C. §121, restriction may be required if two or more independent and distinct inventions are claimed in one application. Under M.P.E.P. §803, the Examiner must examine the application on the merits, even though it includes claims to distinct inventions, if the search and examination of an application can be made without serious burden.

The inventions of groups I-III are not independent. Under M.P.E.P. §802.01, "independent" means there is no disclosed relationship between the subject matter claimed. The inventions of groups I-III relate to agents that inhibit the activation of CXCR4 receptor by SDF-1 in the treatment of rheumatoid arthritis. Applicants therefore maintain that the inventions of groups I-III are not independent and restriction is not proper.

Furthermore, under M.P.E.P. §803, the Examiner must examine the application on the merits if examination can be made without

serious burden, even if the application would include claims to distinct or independent inventions. That is, there are two criteria for a proper requirement for restriction: (1) the invention must be independent and distinct, and (2) there must be a serious burden on the Examiner if restriction is not required. Applicants respectfully submit that there would not be a serious burden on the Examiner if restriction were not required, because a search of the prior art relevant to the non-elected groups would not require a serious burden once the prior art relevant to the elected group has been identified.

Therefore, there would be no serious burden on the Examiner to examine groups I-III together in the subject application. Hence, the Examiner must examine these groups on the merits.

In view of the foregoing, applicants maintain that restriction is not proper under 35 U.S.C. §121 and respectfully request that the Examiner reconsider and withdraw the requirement for restriction.

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorneys invite the Examiner to telephone them at the number provided below.

No fee, other than the $980.00 extension fee, is deemed necessary in connection with the filing of this Communication. However, if any additional fee is required, authorization is hereby given to charge the amount of such fee to Deposit Account No. 03-3125.

Respectfully submitted,

I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to:
Hon. Commissioner of Patents,
Washington, D.C. 20231

6/18/02
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